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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,536	01/04/2002	Dietrich W. Schultz	109476-77US	9380
27189	7590	09/20/2006	EXAMINER	
PROCOPIO, CORY, HARGREAVES & SAVITCH LLP 530 B STREET SUITE 2100 SAN DIEGO, CA 92101			VAUGHN, GREGORY J	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/039,536	SCHULTZ ET AL.	
	Examiner Gregory J. Vaughn	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 30 June 2006.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 35-47 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 35-47 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application

6) Other: _____.

DETAILED ACTION***Action Background***

1. This action is responsive to the applicant's amendment, filed on 6/30/2006.
2. Applicant has cancelled claims 1-34, amended claim 35, and added new claims 36-47.
3. Claims 35-47 are pending in the case, claims 35, 42 and 47 are independent claims.
4. Examiner's rejection of claims 11-16 and 35, made under 35 USC 112 in the *Claim Rejections – 35 USC 112* section of the previous office action (dated 1/30/2006) is withdrawn in view of the cancelled claims.
5. Examiner's rejection of claims 11-16 and 35, made under 35 USC 102, as being anticipated by HSU et al., US Patent 6,574,644 as recited in the previous office action (dated 1/30/2006) are withdrawn in view of the cancelled or amended claims.

Specification

6. The disclosure is objected to because it contains the following embedded hyperlinks and/or other form of browser-executable code:
 - "<http://www.client.com>" on page 7, paragraph 41;
 - "<http://www.atomz.com/images/logo.gif>" on page 8, paragraph 45;

Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

8. Claims 35-39, 41-44, 46 and 47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. **Regarding claims 35-39, 41-44, 46 and 47**, the claimed invention fails to produce tangible result. The claimed invention as a whole must accomplish a practical application. That is, it must produce a *"useful, concrete and tangible result."* *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. (See MPEP 2106.) Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459.

Applicant's invention is directed toward building a list document based on linked documents, by specifying a feature of linked documents, searching the linked documents, generating links to the linked documents, and adding the

links to the list document. Applicant's claims describe the steps taken to manipulate (i.e. provide, search, generate, add and update) the nonfunctional descriptive material (the list document), but fail to describe a tangible result of building a list document. In this case no tangible result is claimed. The claims merely recite, "updating a document" which is an abstract idea of document processing. A process that consists solely of the manipulation of an abstract idea is not concrete or tangible, and therefore not eligible for patenting.

Claims 40 and 45 are statutory in that the claimed invention produces a tangible result when the list document is published, and therefore available to a user of the invention.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

11. Claims 35-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Gautestad US Patent 7,039,860, filed 10/1/1999, patented 5/2/2006.

12. **Regarding independent claim 35**, Gautestad discloses providing a list document that includes a specification of a feature of a linked document, searching a group of linked documents that match the specification, generating a link for the matched document, adding the link to the list, and updating the links of the list document. Gautestad recites: "*Queries to the database are processed by script programs which execute a search engine's algorithms to retrieve all the relevant data records from the database that satisfy a specific query from a user. The search engine then returns an HTML-formatted screen image of a list of "hits" to the user who has submitted the query*" (column 2, lines 18-25). See also Figure 3, where a specification is shown at reference sign 200 (shown as "Query A"); and Figure 4A where a link is shown at reference sign 220.

13. **Regarding dependent claim 36**, Gautestad discloses using a location in a file structure as an identifying feature of the linked document. Gautestad recites: "*An ini-file is a text file containing various parameters for the system setup such as, for example, field captions, location of various file types, etc. In NetSpinner, one can allow for other program settings that can be easily modified if the settings were read from various text files, such as ini-files. Such files instructing NetSpinner to update the local website copy only de-*

activates the "Update Internet" FTP or HTTP function" (column 15, lines 55-62).

14. **Regarding dependent claim 37**, Gautestad disclose the identifying information as a document name in Figure 5A, at reference sign 256 (shown as the file name "c:\picture1.jpg").

15. **Regarding dependent claim 38**, Gautestad discloses generating a link in Figure 4A, at reference sign 220. A link is a pointer to the location of the file and inherently is based on a file system location.

16. **Regarding dependent claim 39**, Gautestad discloses tracking files that are added, deleted or relocated. Gautestad recites: "*This invention relates generally to a method, system, and computer program product for production, revision, and hierarchical organization of electronic documents for local or global electronic network publication in the form of web browser- or word processor-accessible documents containing automatically updated lists with summary information of and hyperlinks to an underlying set of electronic documents with detailed information for each item in a given list*" (column 1, lines 8-15).

17. **Regarding dependent claim 40**, Gautestad discloses updating the list document when the list document is published. Gautestad recites: "*A method, system and computer program product for revising and publishing electronic documents*" (abstract).

18. **Regarding dependent claim 41**, Gautestad discloses updating the list document when a content file is created or changed. Gautestad recites: "*This invention relates generally to a method, system, and computer program product for production, revision, and hierarchical organization of electronic documents for local or global electronic network publication in the form of web browser- or word processor-accessible documents containing automatically updated lists with summary information of and hyperlinks to an underlying set of electronic documents with detailed information for each item in a given list*" (column 1, lines 8-15).

19. **Regarding claims 42 and 47**, the claims are directed toward a system and a method, respectively, for the method of claim 35, and are rejected with the same rationale.

20. **Regarding claims 43 and 44**, the claims are directed toward a system for the method of claims 36 and 37, respectively, and are rejected with the same rationale.

21. **Regarding claims 45 and 46**, the claims are directed toward a system for the method of claims 40 and 41, respectively, and are rejected with the same rationale.

Response to Arguments

22. Applicant's arguments with respect to claim 35 have been considered but are moot in view of the new grounds of rejection, as described above.

23. Regarding the examiner's objection to the hyperlinks recited in the specification, applicant argues that: "*applicant does not intend for the hyperlinks cited in the disclosure to be active links*" (page 5, second paragraph, of the response filed 6/30/2006). Applicant is directed to the objection that is restated above. See MPEP 608.01 section VII where it clearly states hyperlinks are not permitted. See also 37 CFR 1.57(d).

Conclusion

24. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action.

In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



STEPHEN HONG
SUPERVISORY PATENT EXAMINER

Gregory J. Vaughn
Patent Examiner
September 14, 2006